

08-27-08

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Ralph E. Jocke  
Patent  
&  
Trademark Law

August 25, 2008

Director of Technology Center 3600  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Attn: Art Unit 3691  
Patent Examiner Alexander Kalinowski

Re: **Application No.:** 09/639,310  
**Confirmation No.:** 9530  
**Applicants:** Jay Paul Drummond, et al.  
**Title:** Automated Banking Machine  
Customer Profile Method  
**Docket No.:** D-1077+18

Sir:

Please find enclosed a "Petition to withdraw holding of abandonment" for filing.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the Petition and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke  
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Director of Technology Center 3600, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 25 day of August 2008.

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rej@walkerandjocke.com  
E-MAIL



D-1077+18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
<b>Jay Paul Drummond, et al.</b>	)	
	)	
Application No.: <b>09/639,310</b>	)	Art Unit 3691
	)	
Confirmation No.: <b>9530</b>	)	
	)	Patent Examiner
Filed: <b>August 14, 2000</b>	)	Alexander Kalinowski
	)	
Title: <b>Automated Banking Machine</b>	)	
<b>Customer Profile Method</b>	)	

Director of Technology Center 3600  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

Applicants received a Notice of Abandonment dated August 14, 2008. Applicants respectfully petition that the improper holding of abandonment be withdrawn because a proper reply was timely filed on June 17, 2008 in response to the BPAI decision mailed April 18, 2008.

The Abandonment Notice indicates that Applicants failed to timely file a proper reply to an Office letter mailed on April 17, 2008. The Abandonment Notice states that no reply was received by the Office. The Applicants respectfully disagree. Correspondence (which included Applicants' reply) was in fact timely filed on June 17, 2008 as Express Mail Post Office with the U.S. Postal Service.

1. This petition is being filed promptly after I became aware that the Office had no evidence of receipt of the deposited correspondence.

2. Evidence is attached herewith showing that the correspondence was timely filed. The evidence shows that the number (EM 136414316 US) of the "Express Mail" mailing label was placed on each piece of the correspondence prior to the original mailing.

3. Attached is a copy of the originally deposited correspondence showing the number (EM 136414316 US) of the "Express Mail" mailing label thereon; a copy of the returned postcard receipt; a copy of the "Express Mail" mailing label showing the "date-in"; and the U.S. Postal Service's delivery record for "Express Mail" mailing number "EM 136414316 US".

The returned postcard receipt shows USPTO address, docket number, application number, inventor's name, item listing (i.e., "Response to Board decision 4-18-08"), Express Mail number "EM 136414316 US", and USPTO mail date stamp thereon. The USPTO mail date stamp provides evidence that the correspondence was physically received in the USPTO on June 18, 2008. The returned postcard receipt serves as *prima facie* evidence of receipt in the USPTO of all items listed thereon on the date stamped thereon by the USPTO (MPEP § 503).

The U.S. Postal Service's delivery record for the "Express Mail" mailing number "EM 136414316 US" also provides further evidence that the USPTO physically received the deposited correspondence on June 18, 2008.

4. I declare that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying this petition are true copies of the correspondence, mailing label, and returned postcard receipt originally mailed or received. I deposited the documents as "Express Mail" with the U.S. Postal Service on June 17, 2008 at approximately 4:49 p.m.

Respectfully submitted,



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Ralph E. Jocke      Reg. No. 31,029  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000



EM136414316US

Walker  
&  
Jocke

a legal professional association

Ralph E. Jocke  
Patent  
&  
Trademark Law

June 11, 2008

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450Attn: Art Unit 3624  
Patent Examiner Debra F. Charles

Re: **Application No.:** 10/377,483  
**Confirmation No.:** 9530  
**Applicants:** Jay Paul Drummond,, et al.  
**Title:** Automated Banking Machine  
Customer Profile Method  
**Docket No.:** D-1077+18

Sir:

Please find enclosed Applicants' Response to the Board decision mailed April 18, 2008.  
Also enclosed is a declaration pursuant to 37 C.F.R. § 1.132.

No fee is deemed required. However, the Commissioner is authorized to charge any  
necessary fee associated with this Response and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke  
Reg. No. 31,029CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited  
with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Mail Stop  
Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 17 day of June 2008.

EM 136414316 US  
Express Mail Label No.  
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MEDINA330 • 225 • 1669  
CLEVELAND330 • 722 • 6446  
FACSIMILErej@walkerandjocke.com  
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601



D-1077+18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
<b>Jay Paul Drummond, et al.</b>	)	
	)	
Application No.: <b>09/639,310</b>	)	Art Unit 3624
	)	
Confirmation No.: <b>9530</b>	)	
	)	
Filed: <b>August 14, 2000</b>	)	Patent Examiner
	)	Debra F. Charles
	)	
Title: <b>Automated Banking Machine</b>	)	
<b>Customer Profile Method</b>	)	

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that prosecution be reopened in response to the Board decision mailed April 18, 2008. Kindly amend the above identified Application without prejudice as follows:

## Amendments to the Claims

1. (previously presented) A method of operating an automated transaction machine comprising:

- a) reading customer identification information from a card with a card reading device in operative connection with an automated transaction machine;
- b) accessing at least one customer profile value from at least one data store, responsive to the customer identification information;
- c) generating at least one web page responsive to the at least one customer profile value; and
- d) displaying the at least one web page at the machine through operation of a browser, wherein the at least one web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine.

2. (original) The method according to claim 1, further comprising:

- e) receiving an input from an operator of the automated transaction machine; and

f) modifying the at least one customer profile value in the data store responsive to the input.

3. (original) The method according to claim 2, wherein the data store includes a remote database.

4. (original) The method according to claim 2, wherein the data store includes a smart card.

5. (previously presented) The method according to claim 1, wherein in step (a) the reading device includes a smart card reader device, and wherein the customer identification information is read from a smart card.

6. (currently amended) The method according to claim 2,

wherein the at least one customer profile value accessed in step (b) includes a customer profile language value,

wherein the customer profile language value is representative of ~~the~~ a preferred ~~natural~~ reading language of the machine customer,

wherein the at least one web page displayed in step (d) is in a reading language that corresponds to the customer profile language value accessed in step (b), wherein the at least one web page displayed includes a plurality of customer selectable options for



performing a function with the machine, wherein a displayed one of the customer selectable options corresponds to a dispensing of an amount of cash, wherein another displayed one of the selectable options corresponds to changing the preferred reading language of the machine customer to a different preferred reading language, is generated in a language that corresponds to the value;

wherein the input received in step (e) is representative of customer selection of the option to change the preferred reading language to a different preferred reading language, wherein the different preferred reading language differs from the reading language of the at least one web page displayed in step (d),

wherein the input is modifying in step (f) includes changing the customer profile language value to be representative of a in the at least one data store of the different value for the preferred natural reading language, wherein the change causes a next reading of the customer identification information by the card reading device to produce display of at least one web page at the machine in the different preferred reading language ; .

7. (original) The method according to claim 2, wherein the customer profile value is representative of a fast cash amount, wherein the web page includes a selectable option which corresponds to having the automated transaction machine dispense an amount of cash that is equal to the fast cash amount, wherein step (f) includes modifying the fast cash amount.

8. (currently amended) Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 6  $\pm$ .

9-10. (canceled)

11. (currently amended) ~~The method according to claim 10;~~ A method comprising:

- a) receiving with a reading device of an automated transaction machine, customer identification data from a machine customer, wherein the machine is affiliated with a transaction host;
- b) accessing a plurality of customer profile values that correspond to the customer identification data, wherein the customer profile values include a last withdrawal amount value representative of a ~~previously withdrawn~~ an amount of cash most recently withdrawn by the machine customer in a transaction involving the transaction host ;

c) displaying a web page in a browser with the automated transaction machine,  
wherein the web page includes a plurality of selectable options for performing a  
transaction with the automated transaction machine, wherein one a first selectable  
option of the selectable options corresponds to a dispensing of an a first amount of  
cash equal to the last withdrawal amount value, wherein a second selectable  
option of the selectable options is associated with a dispensing of a second  
amount of cash having a value different from the last withdrawal amount value,  
wherein at least one of the selectable options is produced responsive to at least  
one of the accessed customer profile values;

d) receiving customer input associated with either customer selection of the first  
selectable option or customer selection of the second selectable option,

wherein received customer input associated with customer selection of the  
first selectable option is adapted to cause the first amount of cash to be  
dispensed,

wherein received customer input associated with customer selection of the  
second selectable option is adapted to both

cause the second amount of cash to be dispensed, and

cause the last withdrawal amount value included in the customer profile values to be changed to the value of the second amount of cash;

- e) ~~wherein step (c) includes dispensing of a selected amount of cash with a cash dispenser device~~ of the machine, an amount of cash corresponding to the customer input received in step (d); and
- f) ~~wherein step (f) includes modifying~~ updating the last withdrawal amount value included in the customer profile values to reflect ~~with~~ a value that corresponds to the amount of cash dispensed in step (e) ~~selected amount of cash.~~

12. (canceled)

13. (previously presented) A method comprising:

- a) receiving at least one customer identification value with an automated transaction machine;
- b) accessing a customer profile from a data store, wherein the customer profile corresponds to the customer identification value, wherein the customer profile includes a customer type value, wherein a customer type value differentiates

between classes of customers with regard to operations available with the automated transaction machine; and

- c) displaying a web page in a browser of the automated transaction machine, wherein the web page is loaded responsive to the customer type value.

14. (currently amended) The method according to claim 13,

wherein the classes of customers include a first class corresponding to a consumer,

wherein when the customer type value accessed in step (b) is directed to the first class, the web page loaded in step (c) includes a plurality of selectable transaction options for performing financial transactions with the machine,

~~wherein when the customer type value corresponds to a~~ the classes of customers include a  
second class corresponding to an authorized servicer of automated transaction machines,  
the

wherein when the customer type value accessed in step (b) is directed to the  
second class, the web page loaded in step (c) includes a plurality of selectable  
servicer options for ~~servicing~~ associated with maintenance of the automated  
~~transaction machine.~~

15. (previously presented) The method according to claim 13, wherein when the customer type value corresponds to a consumer, the web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine.

16. (original) The method according to claim 15, further comprising:

- d) receiving an input that corresponds to one of the selectable transaction options;  
and
- e) dispensing an amount of cash with a cash dispenser device responsive to the input.

17. (original) The method according to claim 13, wherein the web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine, and wherein the method further comprises:

- d) receiving an input that corresponds to one of the selectable transaction options;  
and
- e) updating the customer profile data responsive to the input.

18. (currently amended) The method according to claim 13

wherein the web page displayed in step (c) includes a plurality of customer selectable options, wherein the plurality of customer selectable options include a customer selectable option corresponding to a cash withdrawal transaction selection,

wherein when the customer type value corresponds to a first class of customer, the plurality of customer selectable options in the web page displayed in step (c) includes a first customer selectable option to perform a first bill pay transaction with the automated transaction machine,

wherein when the customer type value corresponds to a second class of customer, the plurality of customer selectable options in the web page displayed in step (c) does not include the first customer selectable option to perform a bill pay transaction with the automated transaction machine.

19. (original) The method according to claim 18, wherein the first transaction corresponds to bill payment.

20. (currently amended) Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 17 ~~13~~.

21-22. (canceled)

23. (currently amended) ~~The method according to claim 21;~~ A method comprising:

- (a) receiving customer identity information at an ATM from a customer, wherein the ATM includes a cash dispenser operative to dispense cash;
- (b) accessing a customer profile unique to the customer responsive to the customer identity information received in step (a), wherein the customer profile includes marketing information unique to the customer;
- (c) retrieving the marketing information from the customer profile accessed in step (b);
- (d) determining from the marketing information retrieved in step (c) that the customer did not previously receive a particular promotion;
- (e) selecting a targeted advertisement responsive to the determination in step (d), wherein the targeted advertisement includes the particular promotion;
- (f) displaying a web page in a browser of the ATM, wherein the web page includes the targeted advertisement selected in step (e), and wherein the targeted advertisement includes at least one plural customer selectable options option,



wherein a first one of the selectable options corresponds to the particular promotion; ~~wherein the method further comprises:~~

(f) (g) receiving ~~an input with the ATM, selection~~ from the customer ~~consumer~~ that corresponds to the first one of the selectable options ~~option~~; and

(g) (h) responsive to the selection received in step (g), updating the marketing information in the customer profile to reflect that the customer received the particular promotion ~~responsive to the input.~~

24. (currently amended) Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 23 ~~21~~.

25. (previously presented) A method comprising:

(a) receiving customer identification information with an ATM, wherein the ATM includes at least one banking transaction function device, wherein the at least one banking transaction function device includes a currency dispenser operative to dispense currency,

- (b) displaying at least one web page at the ATM through operation of at least one browser, wherein the at least one web page respectively corresponds to the received customer identification information, wherein the at least one web page includes a plurality of banking transaction selections associated with performing banking transactions with the ATM, and wherein at least one of the selections includes a currency withdrawal request.

26. (previously presented) The method according to claim 25 and further comprising:

- (c) receiving an input corresponding to a selection with the at least one input device of the ATM,
- (d) responsive to step (c), accessing at least one markup language document from at least one data store, wherein the at least one markup language document includes at least one instruction adapted to cause operation of at least one banking transaction function device associated with carrying out a banking transaction function corresponding to the selection,
- (e) responsive to the at least one instruction accessed in step (d), operating the at least one banking transaction function device in carrying out the banking transaction function.

27. (previously presented) The method according to claim 26 wherein step (a) includes reading customer identification information with a reading device in operative connection with the ATM, and further comprising:

(f) responsive to the customer identification information read in step (a),  
accessing at least one customer profile from at least one data store,

(g) generating at least one web page responsive to the at least one customer  
profile,

wherein step (b) includes displaying the at least one web page generated in  
step (g).

28. (previously presented) The method according to claim 27 wherein in step (d) the at least one markup document is accessed via the Internet and includes a currency dispense instruction operative to cause operation of the currency dispenser,

wherein step (e) includes operating the currency dispenser to dispense currency  
responsive to the currency dispense instruction.

29. (new) The method according to claim 23 and further comprising

- (i) determining from the marketing information that the customer is not a customer associated with a particular financial institution;

wherein step (d) includes determining from the marketing information that the customer did not previously receive a particular promotion for the particular financial institution;

wherein step (f) includes selecting a targeted advertisement responsive to the determinations in steps (d) and (i), wherein the targeted advertisement includes the particular promotion for the particular financial institution.

30. (new) The method according to claim 23

wherein step (e) includes generating the targeted advertisement at the ATM.

31. (new) The method according to claim 30 and further comprising

- (i) receiving with the ATM, information from various sources based on the marketing information in the customer profile;

wherein step (e) includes operating the ATM to generate customized transaction options based on the information received in step (i), wherein the customized transaction options include the targeted advertisement.

32. (new) The method according to claim 23

- (i) receiving with the ATM, information from various sources based on the customer identity information received in step (a),

wherein step (e) includes operating the ATM to generate customized advertisement options based on the information received in step (i),

wherein step (h) includes updating the marketing information in the customer profile to reflect that the customized advertisement options generated in step (e).

33. (new) The method according to claim 23 and further comprising

- (i) receiving with the ATM, selection from the customer that corresponds to a particular transaction;

wherein step (e) includes selecting a targeted advertisement based on a particular transaction device of the ATM which is required to carry out the particular transaction.

## **REMARKS**

Applicants respectfully request that prosecution be reopened. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claims 1-8, 11, 13-20, and 23-29 are pending. Claims 29-33 have been added to replace canceled claims 9-10, 12, and 21-22. Claims 6, 8, 11, 14, 18, 20, 23, and 24 have been amended. No new matter has been added.

### **The Rejections**

Claims 6-7, 11, 13-16, 18-20, and 23 were newly rejected pursuant to 37 C.F.R. § 41.50(b) in the Board decision mailed April 18, 2008. The new rejections are:

- 1). Claims 13-15, 18, and 20 were rejected pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, and Clausing.
- 2). Claims 6, 7, 11, and 23 were rejected pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, and Patterson.
- 3). Claim 16 was rejected pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, Clausing, and Patterson.
- 4). Claim 19 was rejected pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, Clausing, and Martin.

### **Acknowledgment of allowability by the Board**

Claim 17 was deemed allowable in the Board decision. Applicants reserve the right, subsequent to final action by the Board on the deferred affirmance, to later place claim 17 into an independent format.

## **Arguments**

Applicants respectfully traverse the new rejections. Nevertheless, claims have been amended to advance prosecution. As can be seen, claims 6, 11, 14, 18, and 23 have been amended to recite additional specific features and relationships that further patentably distinguish these claims over the applied art.

### **Claim 6**

The decision at page 24 states “Dependent claims 6 . . . require using the customer profile for selecting a language . . . and modifying the language . . . The Examiner essentially found that the ATM’s in Wagner performed these functions”. The Statement is unclear as the Office previously admitted (e.g., the Examiner’s Answer at page 12) that Wagner did not teach or suggest the recited features and relationships. Nor does Wagner discuss any “language” in the manner recited.

The decision at page 25 states “The Examiner took official notice for the pre-existence of language selection”. This Statement is also unclear. Nowhere in the Examiner’s Answer regarding claim 6 did the Examiner assert “official notice”. Thus, the Board’s new reliance on Gatto to apparently support this (alleged) assertion of “official notice” is further unclear.

Patterson (at col. 1, lines 21-28) mentions an ATM which operates in a predictive manner to predict the transaction most likely to be requested by the user, in accordance with that user’s habitual transaction requests. In Patterson, language is not a transaction. Nor does Patterson discuss or mention “language”. Nor does Patterson predict, based on a user’s habitual transaction requests, which language the user would request. Nor does Patterson have any need

to predict a language, especially since a user would not be in the habit of changing their language so often that predictive analysis would be required.

Gatto merely indicates (at col. 1, lines 23-24) that a user can conventionally manually use keys to select “the language for the display (English, Spanish, etc.)”. Gatto is actually directed to having user-defined transactions be displayed on a customized menu for the user (e.g., col. 8, lines 29-32). Gatto defines transactions (e.g., col. 3, lines 12-31). In Gatto, changing a language is not a transaction. Thus, Gatto cannot alleviate the deficiencies of Patterson.

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 6.

#### **Claim 11**

The decision at pages 24-25 states “Dependent claims . . . 11 require using the customer profile for selecting . . . and modifying . . . last withdrawal amount. The Examiner essentially found that the ATM’s in Wagner performed these functions, except for tracking the last withdrawal amount”. The Statement is unclear because the Office previously admitted (e.g., the Examiner’s Answer at pages 12-13) that Wagner did not teach or suggest the recited features and relationships. Nor does Wagner discuss any “last withdrawal amount” in the manner recited.

The remainder of the decision’s discussion regarding the rejection of claim 11 (i.e., at decision pages 25-26) fails to even address the recited feature of the “last withdrawal amount”. Thus, no *prima facie* showing of obviousness has been established by the Board.



Patterson's predictive manner to predict the transaction most likely to be requested by the user does not correspond to the recited "last withdrawal amount" feature. Nor is there any need for Patterson to predict, based on a user's habitual transaction requests, what factually occurred (e.g., the last withdrawal amount). Thus, Patterson teaches away from (and is non analogous to) a selectable option of a "last withdrawal amount". Gatto likewise does not teach or suggest the "last withdrawal amount" feature.

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 11.

#### **Claim 14**

The Board (at decision pages 27-28) relies on Clausing to alleviate the admitted deficiencies of the other references with regard to "the customer type value corresponds to a servicer of automated transaction machines and the web page includes a plurality of selectable servicer options for servicing the automated transaction machine". However, Clausing does not discuss a "servicer". Therefore, the Board, without any supporting evidence of record, alleged (at decision page 28) that "a servicer is simply one who provides service, and operating a piece of equipment is a form of service, as the machine is in service".

This allegation by the Board lacks any basis, is without merit, and is just another example of the faulty decision reading like a fiction novel. Applicants' specification provided ample support for an automated transaction machine servicer. Further, one of ordinary skill in the art easily understands what constitutes a "servicer of automated transaction machines". There is an entire servicer industry. The record shows that even the Examiner understood the widely

accepted “servicer” term. The unreasonable definition by the Board attributed to the recited “servicer” language is further evidence that the Board did not correctly apply the standard of review to that of one of ordinary skill in the art.

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 14.

### **Claim 18**

The Board (at decision pages 27-28) relies on Clausing to alleviate the admitted deficiencies of the other references with regard to “the customer type value corresponds to a first class of customer, the web page includes a first option to perform a first transaction with the automated transaction machine, wherein when the customer type corresponds to second class of customers, the web page does not include the first option”. However, Clausing is not directed to displaying a web page that has a plurality of customer selectable options, including a cash withdrawal transaction selection option. Nor does Clausing relate displaying one web page (having the cash withdrawal transaction selection option and a bill pay option) to a first class of customer, and another (different) web page (having the cash withdrawal transaction selection option but not the bill pay option) to a second class of customer. Clausing does not *display* specific options. Clausing has transaction selector keys (31), including deposit/payment selector keys (32), cash withdrawal selector keys (34), and fund transfer selector keys (35). A customer in Clausing is not limited in what transactions can be selected (or attempted) by a customer. Rather, any customer in Clausing can select any of the easily reachable keys (31).

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 18.

**Claim 23**

The references do not teach or suggest using marketing information of a customer profile in the manner recited, including retrieving, determining from, and updating the marketing information. Nor do the references teach or suggest displaying an ATM web page of a targeted advertisement which has plural customer selectable options with one of the options corresponding to a particular promotion, especially where the targeted advertisement was selected responsive to a determination made based on the marketing information.

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 23.

**The Declaration Pursuant to 37 C.F.R. § 1.132**

The attached declaration under 37 C.F.R. § 1.132 further negates the reasoning relied upon by the Board in the decision. The declaration provides evidence that it would not have been obvious to a person having ordinary skill in the art at the time of the invention to have combined the applied references in the manner reasoned by the Board, especially to have produced the recited invention (as set forth in the appealed claims).

### **The Decision Is Legally Improper**

The decision was decided by at least one person who was unconstitutionally appointed (by a PTO director) as a patent appeals judge. Thus, the decision rendered by the Board (and mailed April 18, 2008) is *prima facie* moot. As a result, the original appealed claims remain pending and await a decision by a Board panel comprised of patent appeals judges appointed in a constitutional manner.

Lack of evidentiary rebuttal by the Office regarding Applicants' accusation that the Board panel that rendered the decision did not have legal authority to do so, will be taken as an admission by the Office confirming the illegality of the decision. Applicants reserve all rights regarding the originally appealed claims, including a new full review thereof by a proper Board panel.

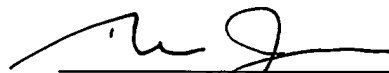
### **The Gatto Reference**

Applicants request that the Gatto reference mentioned in the decision be properly made of record by being listed on form PTO-892.

### **Conclusion**

The undersigned is willing to discuss any aspect of the Application at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke      Reg. No. 31,029  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000



D-1077+18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
<b>Jay Paul Drummond, et al.</b>	)	
Appeal No.: 2007-4204	)	
Application No.: 09/639,310	)	Art Unit 3624
Confirmation No.: 9530	)	
Filed: August 14, 2000	)	Patent Examiner
	)	Debra F. Charles
Title: Automated Banking Machine	)	
Customer Profile Method	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**DECLARATION PURSUANT TO 37 C.F.R. § 1.132**

I, Mark D. Smith, hereby declare as follows:

1. I am an employee of Diebold, Incorporated and have worked in the past for InterBold, a wholly owned subsidiary of Diebold, Incorporated (collectively referred to hereafter as "Diebold"). I have extensive experience as an engineer and engineering manager in the development of automated banking machines and associated computer software for those machines. I began working in the automated banking machine industry in approximately 1977.
2. Based on my knowledge and experience, a person having ordinary skill in the art of automated banking machines at the time the present invention was made would have a four-year college degree in engineering, such as mechanical or electrical engineering, and have at least four years of experience in designing automated banking machines (or equivalent years of working experience in the design of automated banking machines).
3. I have reviewed the subject matter disclosed in the above-mentioned application (hereinafter "application").
4. I have reviewed the appealed claims (hereinafter "claims") involved in the Board decision decided April 17, 2008 (hereinafter "decision").
5. I have reviewed the references involved in the decision, including the patent to Wagner (US 5,742,845).

A person having ordinary skill in the art of automated banking machines at the time of the invention (corresponding to the application) would not have considered an ATM to be a "non-standard I/O device" as described in Wagner. Wagner's extended protocols are directed to use with non-standard I/O devices.

A person having ordinary skill in the art of automated banking machines at the time of the present invention would have determined from Wagner that an ATM is not a "non-standard I/O device". It would have been determined that Wagner distinguishes "non-standard" I/O devices from "standard" I/O devices. For example, Wagner, as best understood, implies that *standard* I/O devices are those I/O devices that can already be supported by Internet protocols, such as computers, whereas *non-standard* I/O devices are those I/O devices which do not have the capability of direct communication on a network, so they require use of other communication interfaces such as RS-232C. That is, Wagner indicates that a non-standard I/O device is not a computer (which an ATM comprises). For example, note Wagner at col. 3, lines 62-66; col. 4, lines 4-12; col. 5, lines 43-47; col. 6, lines 16-20; col. 9, lines 60-63; col. 10, lines 5-6; and abstract lines 5-6. This indicates to a person having ordinary skill in the art of automated banking machines at the time of the present invention that Wagner teaches away from an ATM being a non-standard I/O device, and thus it would not have been obvious to have used Wagner's extended protocols with an ATM.

Wagner is directed to a system that permits a consumer to initiate a transaction and order from a merchant, and then switch to a conventional secure (credit card) processing application for the confidential financial aspects of the transaction. This

conventional secure processing application includes use of a known (not an extended) protocol, such as the VISA protocol. However, ATMs at the time of the present invention communicated using proprietary debit card protocols, such as those used by Cirrus® and Plus®, and not Visa point of sale credit card processing protocols. This indicates to a person having ordinary skill in the art at the time of the present invention that an ATM is further removed from being a “non-standard I/O device” as described in Wagner. As a result, it would not have been obvious to a person having ordinary skill in the art at the time of the present invention to have used Wagner’s extended protocols with an ATM, especially to control an ATM.

A person having ordinary skill in the art of automated banking machines at the time of the present invention would not have been able to make and use the purported invention in Wagner based on the disclosure provided by Wagner. As best understood, Wagner’s disclosure is non-enabling. For example, Wagner’s use of the term “non-standard I/O device” would have been unclear to a person having ordinary skill in the art at the time of Wagner’s application. Wagner provides examples of non-standard I/O devices, such as smart card reader (32), PIN pad (34), magnetic card swipe reader (36), and printer (38). To a person having ordinary skill in the art at the time of Wagner’s application, “I/O” means “input/output.” However, none of these devices is technically an input/output device. A smart card reader, PIN pad, and magnetic card swipe reader are input-only devices. A printer is an output-only device. Thus, Wagner’s use of “I/O device” is not consistent with known accepted terminology in the field. Nor did Wagner specifically redefine the accepted meaning of an “I/O device”.



Nor is the term “non-standard I/O device” one that has an accepted meaning that is well known in the art. Nor is this term defined to a sufficient degree by Wagner to overcome the absence of an accepted meaning in the art. The scope of this term appears to improperly try to encompass every conceivable structure that is not a “standard I/O device.” Such examples would even include paper and a pencil. The undue breath of the term renders the Wagner disclosure indefinite and non enabling. A person having ordinary skill in the art at the time of Wagner’s application would not have been able to ascertain the scope and meaning of Wagner’s disclosed purported invention. A person having ordinary skill in the art at the time of Wagner’s application would have been unable to carry out Wagner’s disclosed purported invention, even with undue experimentation. As a result, Wagner does not teach sufficient information that would have enabled a person having ordinary skill in the art at the time of Wagner’s application to make and use Wagner’s purported invention.

A person having ordinary skill in the art at the time of the present invention would not have considered or recognized a browser to be a requirement of Wagner’s system. Wagner’s system does not specifically teach use of a browser. Nor is there any evidence that Wagner’s system uses or requires a browser. A person having ordinary skill in the art at the time of the present invention would have also understood that HTML documents could be interpreted without a browser. Furthermore, Wagner’s examples of non-standard I/O devices (e.g., smart card reader, PIN pad, magnetic card swipe reader, and printer) do not require a display device, let alone the capability or requirement to display a web page.

It would not have been obvious to a person having ordinary skill in the art at the time of the present invention to have combined the references as alleged by the Office. The present application was filed in 2000 and claims priority back to 1996. At the time of the present invention, ATMs did not employ web pages (except for Diebold). Nor would a person having ordinary skill in the art at the time of the present invention have considered employing Wagner's complicated (and non-enabling) relationship between extended protocols and non-standard I/O devices for ATMs, especially when ATMs did not need such devices to have direct network communication. Furthermore, it would not have been obvious to a person having ordinary skill in the art at the time of the present invention, in view of the Wagner disclosure, how such an employment of any of the teachings in Wagner could have feasibly been carried out, especially to have achieved the invention recited in the claims.

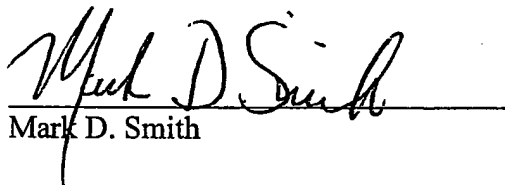
6. I have reviewed the decision. The decision is faulty because, in contrast to an understanding of Wagner by a person having ordinary skill in the art at the time of the present invention (as discussed above), it attributes enablement to Wagner and it also attributes to Wagner features which are not taught or suggested by Wagner.
7. The decision is also faulty because it did not correctly apply the level of ordinary skill in the art at the time of the present invention. As the decision is best understood, the Board applied a level of ordinary skill in the art in 2008. Again, the application covering the present invention was filed in 2000 and claims priority back to 1996.

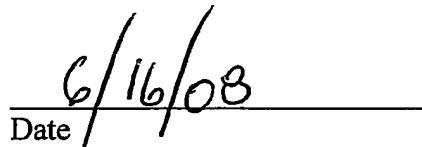
8. The decision is also faulty because there are significant differences between what was disclosed in the applied references and what was recited in the claims. These differences would not have been obvious to a person having ordinary skill in the art at the time of the present invention. Before the present invention, there was no recognized need (or known way) for an automated transaction machine to generate a web page responsive to a customer profile value, and to display the web page through operation of a browser, especially where the web page included selectable transaction options for performing transactions with the automated transaction machine.

To a person having ordinary skill in the art at the time of the present invention, the references, whether taken alone or in combination, did not teach or suggest the features and relationships recited in the claims. Nor would a person having ordinary skill in the art at the time of the present invention have any reason or have recognized any teaching, suggestion, or motivation in view of the references, to have combined the reference's teachings to have obtained the features and relationships of the claims. Rather, a person having ordinary skill in the art at the time of the present invention would have recognized the teachings in the references to be non analogous and incompatible, and that no benefit would have been obtained in prior automated transaction machine operations based on combining such teachings. Conversely, a person having ordinary skill in the art at the time of the present invention would have recognized that combining the teachings would have destroyed the function and intended use of prior automated transaction machine operations.

In conclusion, it would not have been obvious to a person having ordinary skill in the art at the time of the present invention, having full view of all the applied references, to have produced the features and relationships recited in the claims.

9. I hereby declare that all statements herein of my own knowledge are true, that all statements made on information and belief are believed to be true, and that the statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both (18 U.S.C. § 1001), and may jeopardize the validity of the application or any patent issuing thereon.

  
Mark D. Smith

  
Date



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